

REMARKS

Claims 1-19 remain in this application. Claims 1-19 have been amended. The Examiner has acknowledged that claims 9 and 11-19 are directed to allowable subject matter.

In paragraph one of the Office Action dated March 4, 2003, the Examiner noted that there was some confusion regarding what the respective pages were for the originally-filed specification as well as the amended pages of the specification pursuant to the PCT Amendment of July 1, 1999.

In response, Applicants acknowledge that the PCT documents from the International Office indicate that the amended pages of the specification were pages 15, 17, 18, 18A and 19. However, Applicants submit that after the English translation of such, amended pages for the English version of this specification were pages 13-17 and 17A. The subsequent amendments to all such pages of the specification found in the Preliminary Amendment filed with the U.S. Patent Office on March 2, 2002 were based on the above-referenced listing of original/amended pages. Applicants therefore respectfully submit that there should be no ambiguity with respect to such Preliminary Amendment and respectfully request that all such amendments proposed therein be entered at this time.

In paragraphs 2-4 of the Office Action, the Examiner rejected claims 1-19 of the present application under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner noted that claim 1 recites the limitation “said first mobile station” in line 13, which does not refer to any previous element. Therefore, there was insufficient antecedent basis for this limitation.

Applicants respectfully acknowledge the error in independent claim 1 and, pursuant to present amendment, have corrected the term in error so as to read “said first mobile parts.” Accordingly, Applicants respectfully request that the § 112 rejection be withdrawn at this time.

In paragraphs 5 and 6 of the Office Action, the Examiner rejected, in particular, independent claim 1 of the present application under 35 U.S.C. § 103(a) as being unpatentable over Hagting (WO 97/15160) in view of Ward (U.S. Patent No. 5,974,320). In sum, the Examiner indicated that the Hagting reference taught all of the elements of independent claim 1, but failed to disclose that the first base stations transmit the first messages which indicate the

first base stations are surrounded by at least one of the second base stations. The Examiner went on to reason, however, that the Ward reference discloses that the first base stations regularly or automatically transmit the first messages having first information indicating that the first base stations are surrounded by at least one of the second base stations network side.

Applicants respectfully submit that it clearly would not have been obvious to combine the references as suggested by the Examiner. Indeed, the Hagting reference describes a system and method for mobile station hand-overs in wireless communications systems wherein the mobile station itself searches its associated radio environment for all of the available synchronous and asynchronous base stations available to it and thereafter stores a list of such connections. Indeed, the fundamental problem addressed by the present invention was also the focus of the Hagting reference - improving the roaming capability of mobile stations in at least partially asynchronous wireless telecommunication networks.

Applicants respectfully submit that, since the Hagting reference already solved the fundamental problem of improving the roaming capability of mobile stations in these environments (yet, in a very different way), a person skilled in this field of art would never even consider combining another reference so as to arrive, for example, at the present invention.

The present invention solves the interruption-free roaming problem by sending first messages together with first information at least for a temporary period from at least one element in a first set of base stations, with the information indicating that each member of the first set of base stations is surrounded by at least one member of the second set of base stations. The present invention takes this alternative approach to addressing the issue because the mobile station which is maintaining a radio connection to a synchronous base station can only locate synchronous base stations and would have to interrupt the connection in order to search for asynchronous base stations. However, because of the transmission of the inventive first message this is no longer necessary.

Conversely, this problem of synchronous mobile stations having to interrupt an existing connection in order to locate asynchronous base stations never arises in the context of the Hagting reference because the mobile stations disclosed therein can themselves find the desired asynchronous base stations in their stored lists. There is absolutely no need pursuant to the Hagting process to send "first messages" as claimed by the present invention to nearby

asynchronous base stations. Indeed, the capabilities of the base station disclosed in the Hagting reference would have to be reconfigured and extended to such a radical extent in order to arrive at the present invention that there simply would be no motivation to do so.

The Examiner also suggested that there might be motivation to combine the cited references so as to "improve the battery life of the mobile unit." However, Applicants respectfully submit that the step of sending the first messages as claimed by the present invention actually requires additional energy and therefore leads to higher energy consumption. Therefore, such motivation could not possibly exist in the context of the present invention.

In light of the above, Applicants respectfully submit that the references cited by the Examiner, either alone or in combination with each other, do not teach or suggest, nor even contemplate, that which is claimed by the present invention. Accordingly, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

It is further noted that no fees are due in connection with this action at this time. If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (0112710-506) on the account statement.

Respectfully submitted,

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